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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,243	08/28/2001	Geoffrey B. Rhoads	P0423	6983

23735 7590 08/26/2002

DIGIMARC CORPORATION
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EXAMINER
VU, VIET DUY

ART UNIT	PAPER NUMBER
2154	6

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/941,243	Rhoads
Examiner	**Art Unit**
Viet Vu	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Dec 3, 2001 (IDS)*.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above, claim(s) *1-6* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *7-14* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-6* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Restriction:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, drawn to specific method of encoding a hyperlink information into an audio signal, classified in class 709, subclasses 219 and class 380, subclasses 4 and 28.

II. Claims 7-14, drawn to a specific method of encoding a hyperlink information into a graphical image, classified in class 709, subclasses 219, and class 380, subclasses 4 and 28.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as subcombinations usable together. It is quite clear that the method of encoding audio signal is different than the method of encoding a graphic image.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Mr. Meyer on Thursday August 22, 2002 a provisional election was made without traverse to

prosecute the invention of Group II, claims 7-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-6 are withdrawn from further consideration by the examiner, see 37 CFR 1.142(b), as being drawn to a non-elected invention.

Non-Art rejections:

3. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F2.d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F2.d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F2.d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F2.d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F2.d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F2.d 937, 214 USPQ 761 (CCPA 1970); In re Longi, 759 F2.d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

4. Claims 7-14 are rejected under the judicially created doctrine of double patenting as being unpatentable over prior U.S. Patent No. 5,841,978.

Although the conflicting claims are not identical, they are not patentable distinct from each other because claims 1-13 of prior patent include all limitations required in current claim 7-14. It is noted that a multimedia content file is a digital data object.

5. Claims 7-14 are further rejected under the judicially created doctrine of double patenting as being unpatentable over prior U.S. Patent No. 6,324,573.

Although the conflicting claims are not identical, they are not patentable distinct from each other because claims 1-17 of prior patent include all limitations required in current claim 7-14. It is noted that a multimedia content file is a digital data object.

Objection to the Specification:

6. A typo error is found in claim 14. Claim 14 should refer to claim 7 instead of claim 1. Correction is required.

Art Rejections:

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 7-10 and 12-14 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Tow, European patent application No. 493,091.

Tow discloses a system and method for embedding linking data onto an image comprising:

a) receiving digital data corresponding to a graphic image (see col 3, lines 29-38),

b) steganographically encoding the image to hide a binary code representing a hyperlink pointer (col 3, lines 38-44 and col 4, lines 51-57),

c) printing the image on physical medium for distributing to user who can decode the address information and use the embedded hyperlink pointer to establish a link to the Internet (see col 4, lines 1-23).

9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10. Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tow.

Tow teachings are still applied as set forth in item 8 above. Tow does not explicitly teach using the address as index to a remote data structure. An official notice is taken that it is well known in the art to use URLs to index web pages at a remote web server.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize such conventional URL indexing for maintaining web pages at a remote web server because it would have enabled user to more easily surf the site.

Conclusion:

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An, can be reached on (703) 305-9678. The fax phone number for this Group is (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

VIET D. VU
PRIMARY EXAMINER

8/22/02